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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/550,819

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Go Watanabe

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EXAMINER

WEBB, SARAH K

ART UNIT

PAPER NUMBER

3731

MAIL DATE

DELIVERY MODE

11/22/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/550,819	Applicant(s) WATANABE ET AL.	
	Examiner SARAH WEBB	Art Unit 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-7,9,10,12-14 and 18-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-7,9,10,12-14 and 18-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/27/2010</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1, 5, and 6 have been considered but are moot in view of the new ground(s) of rejection.

Information Disclosure Statement

2. The information disclosure statement filed 7/27/2010 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered. The copy of the office action corresponding to Japanese App. 2006-506766 was not considered because a translation or summary of relevance was not provided.

Claim Objections

3. Claim 2 is objected to because of the following informalities: the term "and/or" is generally considered to be indefinite and should be changed so that the limitations are listed in the alternative only. Appropriate correction is required.

4. Claims 27-29 are objected to because of the following informalities: "portion" should be "portions". Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 5-7, 9, 10, 12-14, and 18-29 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 6,234,448 (Porat).

Porat discloses a device that includes all the claimed structural features and is *capable of* being used as a surgical holder for grasping tissue. As shown in Figures 4 and 5, Porat illustrates the device's ability to grasp a tubular object (90). The surgical holder in Figure 2 has two grasping plates (20 and 30) that form a first grasping portion at one end of the device (left hand side) and a second grasping portion (right hand side) at the other end of the device. The first grasping portion is defined between a U-shaped opening (56) in the bottom plate (30) and a covering portion (21) of the top plate (20). Rectangular tabs (85) of the top plate extend outwardly beyond the bottom plate to form "non-covering portions." The U-shaped opening (56) has a pair of elongated edge portions (60) that are *capable of* being inserted into a tubular tissue. The second grasping portion is defined between a "recessed portion", or curved cut-out (78), in the bottom plate (30) and a corresponding curved portion (76) in the upper plate (20) that form a generally tubular tissue grasping space (44). Regarding the preamble, the device can include a manipulation member, or tab (70), connected to the grasping member by a "connecting portion" (part of tab 70).

Claims 7, 9 and 10 merely recite language directed toward the intended use of the device that is not given full patentable weight. The device is *capable of* accommodating tissue between the edges of the U-shaped opening of the first plate and the covering portion of the second plate, as required by claim 7. Porat shows that the device is also *capable of* accommodating tissue between two points in Figures 7B and 7C, as required by claim 9. The end of an edge portion is *capable of* being inserted into a tubular tissue, as required by claim 10.

Regarding claims 12-14, the term “a thickness” is sufficiently broad enough to encompass any portion of the first plate. Since the recessed portion is recessed towards some part of the plate with a thickness, Porat meets this claim.

Claims 21-23 only recite limitations directed towards the intended use of the device and are not given patentable weight. The Porat device is *capable of* accommodating a blood vessel, so it meets these claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Porat in view of Mandel et al. (US 2002/0177863).

Porat fails to include a tissue protection material attached to the grasping plates that is permeated with a medicine. Mandel et al. disclose providing an antimicrobial and/or antibiotic coating to the surfaces of various types of surgical clips in order to prevent and kill microorganisms in the area of the clip (paragraphs 33 and 34). It would have been obvious to one of ordinary skill in the art to include a tissue protecting coating containing antibiotic or anti-microbial medicines on the Porat device, as taught by Mandel, in order to prevent growth and to kill microorganisms in the area of the clip.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 3731

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SARAH WEBB whose telephone number is (571) 272-5749. The examiner can normally be reached on 9:00am - 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. W./
Examiner, Art Unit 3731

/TODD E. MANAHAN/
Supervisory Patent Examiner, Art Unit 3776